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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/879,823

Applicant(s)

BARNETT ET AL.

Examiner

Arthur Duran

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 47.52 and 63-102 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 47.52 and 63-102 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 47 and 52 and 63 and 64-102 have been examined.

Response to Amendment

2. The Amendment filed on 1/27/09 is insufficient to overcome the rejection.

Examiner further notes that this office action is in after the February 8, 2006 decision by the Board of Patent Appeals and Interferences (BPAI) which affirmed the Examiner in the rejection of the claims.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/27/09 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 98 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Art Unit: 3622

The Specification discloses coupons and email. But, the Specification does not disclose coupons being sent to the user via email.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 47 and 52 and 63 and 64-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hohorn (5,227,874) in view of Saigh (5,734,823).

Claims 47, 52, 63:

VonKohorn discloses:

storing, at an network-accessible location, information pertaining to a group of available coupons, including information about one or more target audiences of users for which one or more coupons have been designated (col 98, lines 39-45; col 98, lines 57-65; col 105, lines 15-30);

prompting a user to register over the network to be able to print coupons, if the user is not already registered;

receiving registration information from the user (col 3, line 56-66; col 94, lines 1-12; col 94, lines 56-62; col 97, lines 64-70; col 103, line 62-col 104, line 2; Fig. 30; col 109, lines 10-16);

downloading to the computer a unique identifier (col 109, lines 10-16);

receiving, at the network-accessible location, a request from the user for access to at least some of the stored coupon information, wherein the unique identifier is transmitted with the request, and one or more routines are implemented at the network-accessible location to confirm the unique identifier to ensure validity (claims 5 and 6);

displaying coupon information for at least the one or more coupons designated for at least one of the audiences for which the user is a member (col 98, lines 39-45; col 98, lines 57-65; col 105, lines 15-30)

receiving selection information from the user for one or more coupons that the user desires to print based on the displayed coupon information (col 98, lines 39-45; col 98, lines 57-65; col 105, lines 15-30);

printing, via a printer associated with the computer, one or more user-selected coupons based at least in part on instructions from the coupon data management software which is invoked when a user selects a print command (Fig. 30); and

monitoring redemption of the one or more user-selected coupons to prevent fraud (col 17, lines 10-31; col 20, lines 38-44; col 86, lines 10-25; col 87, lines 59-65).

Von Kohorn further discloses the coupon data management software being used at least in connection with the printing of coupons (col 109, lines 10-16).

Also, Von Kohorn discloses enabling a user to download coupon data management software to the at least one remote user computer system to be used at least in connection with the printing of coupons.

Von Kohorn discloses downloading or transmitting instructional signals and programming routines (col 2, lines 55-60; col 109, lines 10-16; col 14, lines 20-25; col 20, lines 57-65; col 26, lines 45-52; col 6, line 56-col 7, line 27).

Von Kohorn further discloses that the programming instructions are ordered as a module or in a group (col 5, lines 31-45; col 4, line 21-35; col 41, lines 28-60).

Von Kohorn further discloses that the programmed response unit can print incentives (col 2, lines 52-56; col 39, lines 24-31; col 41, lines 52-60; col 19, lines 29-34; col 20, lines 57-64; col 22, lines 49-55; col 34, line 67-col 35, line 6).

Also, Von Kohorn discloses that the user's system is specified as a remote system (Fig. 2; page 20, lines 7-11). Furthermore, the printer's are associated with the user's system (page 16, lines 5-10).

Also, Von Kohorn discloses that instructional signals can be transmitted for managing or adjusting coupons:

"(85) The latter method has the advantage that a sponsor or advertiser can have up-to-date promotional information printed on coupons by directing the station which transmits instructional signals to remote locations to include in such signals the desired advertising material. A last-minute-telephone call by an advertiser to the sub-carrier station with directives to incorporate certain instructional signals in the sub-carrier transmission will result in a large number of shoppers being alerted to special sales through up-to-the-minute coupon promotions" (col 19, lines 29-39).

Hence, Von Kohorn discloses downloading or transmitting instructional signals and programming routines where the programming instructions can be ordered as a

module or in a group that is utilized for coupon adjusting, coupon managing, coupon printing which is functionally equivalent to downloading to the one or more remote user systems an incentive data management software module.

Also, Von Kohorn further discloses that the method can utilize a variety of networks (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15).

Von Kohorn does not explicitly disclose that the communication channel can be the Internet.

However, Saigh discloses the utilization of the Internet for the dissemination of a variety of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users (col 14, lines 60-65; col 8, lines 3-6; col 14, line 15-col 15, line 10) and that the coupons can be printed (col 8, lines 59-61).

Saigh further discloses that the service system is associated with an Internet web site (col 14, lines 15-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's utilization of the Internet to Von Kohorn transmitting coupons. One would have been motivated to do this because the Internet is a readily available network for transmitting information.

Von Kohorn does not explicitly disclose wherein the unique identifier is encrypted and transmitted with the request, and one or more routines are implemented at the Internet-accessible location to decrypt the unique identifier to ensure validity.

However, Von Kohorn discloses the utilization of encryption related to identifying indicia (col 10, lines 40-45) and Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder').

Von Kohorn further discloses the user transmitting the unique user identifier and also that the user identifier can be a code (col 61, lines 34-55; col 105, lines 51-65; claims 5, 6). Von Kohorn further discloses that codes, encoding, and encryption are related (col 10, lines 40-45).

And, Saigh further discloses utilizing encryption or encoding (col 15, lines 10-16; claim 10; col 15, line 10-col 17, line 32). Also, Saigh in Figure 12 discloses utilizing the User's ID and Serial Number in 2nd Level Encryption procedures. And, Saigh Figure 8 discloses that a customer enters a site and that a user id and pin or password are entered and transmitted to a central site (Figure 8). And, Saigh discloses reading an encrypted user id and password (Saigh, claim 10). Saigh further discloses transmitting an encoded user id to a central site (col 9, lines 33-64 and col 10, line 40-col 11, line 19; col 9, lines 50-60).

And, Saigh discloses a variety of encryption techniques and that a variety of information that is communicated or transmitted can be encrypted (col 15, line 35-col 17, line 33; col 15, lines 37-47; col 15, line 59-col 16, line 10; col 17, line 20-33)

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn transmitting of unique user identifiers in the form of codes can also be in the form of encryption. One would have been

motivated to do this in order to better secure the communications of the unique identifier of the user.

Alternatively, Von Kohorn discloses encoding and decoding (Fig. 7, 'Coder'; Fig. 8, 'Decoder'). Von Kohorn discloses the central station encoding and the response unit (user unit) decoding. And, as noted above, Von Kohorn discloses that encoding, and encryption are related (col 10, lines 40-45). And, the MPEP 2144.04 VI discloses that reversal or duplication is an obvious modification. Hence, reversing Von Kohorn so that the user unit encodes and the central station decodes is an obvious modification. Or, duplicating the encoder of the central station into the user unit and duplicating the decoder of the user unit into the central station is an obvious modification. And, in regards to Saigh, it is obvious that the encryption of transmission that occur from the central site to the user site can also occur for transmissions from the user site to the central site. Hence, transmitting the unique user identifiers in encrypted form is an obvious form of reversal or duplication.

Additionally, Saigh further discloses a central database (Fig. 11) and e-commerce including further features related to downloading and using coupons (14:15-15:10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's further coupon features to Von Kohorn's coupon downloading. One would have been motivated to do this in order to better offer coupons.

Claim 64: The prior discloses the method of claim 63, wherein the stored coupon information is stored in a repository at the internet-accessible location (Von Kohorn, claims 28, 29; Fig. 7; Saigh, 14:15-15:10; Fig. 11).

Claim 65. The prior discloses the method of claim. 63, wherein the stored coupon information includes data fields (Von Kohorn, Fig. 33).

Claim 66: The prior art discloses the above wherein the data fields include at least a UPC code and an expiration date. Von Kohorn expiration dates (103:1-5). Saigh discloses expiration dates (14:55-60; 2:20-30). Von Kohorn discloses identifying the product the coupon applies to (Fig. 33).

Von Kohorn does not explicitly disclose a UPC code. However, Von Kohorn discloses uniquely identifying the coupon (2:20-25; 3:31-37). And, Von Kohorn discloses utilizing bar codes for identifying particular tickets (98:25-32). Saigh discloses bar codes to identify products (10:45-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn can use bar codes or UPC to identify products. One would have been motivated to do this in order to better identify the products coupons are related to.

Claim 67. The prior discloses the method of claim 65, wherein the data fields include at least product information and a description of the coupon offer (Von Kohorn, Fig. 33).

Claim 68. The prior discloses the method of claim 65, wherein the data fields include at least a redemption amount and a redemption address (Von Kohorn, Fig. 33).

Claim 69. The prior discloses the method of claim 63, wherein storing information pertaining to a group of available coupons further comprises storing advertising materials provided by one or more coupon issuers or coupon distributors (Von Kohorn, Fig. 33; Saigh 14:15-15:10).

Claim 70. The prior discloses the method of claim 69, wherein the advertising materials comprise one or more of graphics, text, recipes, competitions, or inducements (Von Kohorn, Fig. 33; Saigh 14:15-15:10).

Claim 71. The prior discloses the method of claim 69, wherein displaying coupon information further comprises displaying the advertising materials (Von Kohorn Fig. 33, item 1007).

Claim 72. The prior discloses the method of claim 63, wherein registration associates the user with an account (Von Kohorn, claim 5, 6; 3:57-65; 37:15-20; 106:15-23).

Claim 73. The prior discloses the method of claim 72, wherein a household of users may be linked through the account (Von Kohorn, 3:57-65).

Claim 74. The prior discloses the method of claim 72, wherein a household of users may be linked through one account (Von Kohorn, 3:57-65).

Claim 75 The prior discloses the method of claim 63, wherein the user may be an individual user or a household of users (Von Kohorn, 3:57-65).

Claim 76. The prior discloses the method of claim 63, wherein the geographic information comprises zip code information (Saigh, Fig. 8, 9:38-45).

Claim 77: The prior art discloses wherein fixed coupon format data is downloaded with the coupon data management software (Von Kohorn, claim 27; 37:15-20; 3:57-65; 3:31-37; claim 5, 6). Note that the user id is downloaded to the client device and that the user id is printed on the coupon and that the user id functions as fixed coupon data (see Applicant's Fig 3 of Applicant's Specification.).

Claim 78: . The prior art discloses wherein fixed coupon format data is downloaded with the coupon data management software, and is used to format data downloaded to the computer when a user requests a coupon to be printed (Von Kohorn, claim 27; 37:15-20; 3:57-65; 3:31-37; claim 5, 6). Note that the user id is downloaded to the client device and that the user id is printed on the coupon and that the user id functions as fixed coupon data (see Applicant's Fig 3 of Applicant's Specification.).

Claim 79. The prior discloses the method of claim 63, wherein the displayed coupon information includes a product for which a coupon is available, and a discount for that product (Von Kohorn Fig. 33).

Claim 80. The prior discloses the method of claim 63, wherein a coupon has a redemption discount amount associated with a product, and the redemption discount amount for a user depends on certain demographic information associated with the user (Von Kohorn 102:65-70; 102:30-109:2; Fig. 33).

Claim 81. The prior discloses the method of claim 63, wherein the coupons available to a user are based on at least selection history information for the user (Von Kohorn 106:4-10; 102:30-109:2).

Claim 82: Von Kohorn does not explicitly disclose wherein the wherein the coupons available to a user are sorted by categories. However, Von Kohorn discloses coupons and shopping lists (Von Kohorn Fig. 33, 34). Von Kohorn further discloses the user picking multiple coupons (Von Kohorn claim 27;102:30-109:5). And, Saigh discloses coupons and catalogs (Saigh 14:15-15:10). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn's multiple coupons selected can be organized into different categories similar to how a catalog can be organized. One would have been motivated to do this in order to better allow selection of coupons.

Claim 83. The prior discloses the method of claim 63, further comprising providing a user with a shopping list relating to at least one selected coupon (Von Kohorn Fig. 33, the printout includes the related product information for the coupon selected).

Claim 84. The prior discloses the method of claim 83, wherein the shopping list is printed along with the at least one selected coupon (Von Kohorn Fig. 33; 3:31-37).

Claim 85. The prior discloses the method of claim 83, wherein the shopping list is printed separate from the at least one selected coupon (Von Kohorn Fig. 34).

Claim 86: The prior art discloses the above. Von Kohorn does not explicitly disclose wherein printing further comprises printing a unique bar code on the coupon.

However, Von Kohorn discloses uniquely identifying the coupon (2:20-25; 3:31-37). And, Von Kohorn discloses utilizing bar codes for identifying particular tickets (98:25-32). Therefore, it would have been obvious to one having ordinary skill in the art

at the time the invention was made that Von Kohorn can use bar codes to identify coupons. One would have been motivated to do this in order to better identify coupons.

Claim 87. The prior discloses the method of claim 86, wherein the bar code includes a unique identifier (Von Kohorn claim 27).

Claim 88. The prior discloses the method of claim 63, wherein each coupon printed is unique (Von Kohorn claim 27).

Claim 89. The prior discloses the method of claim 63, wherein each coupon printed is printed with a unique bar code (see claim 86 preceding) including unique identification information (Von Kohorn claim 27).

Claim 90. The prior discloses the method of claim 63, wherein each coupon printed is printed with a unique information number (Von Kohorn claim 27; 37:15-20).

Claim 91. The prior discloses the method of claim 63, wherein each coupon printed is printed with a unique bar code (see claim 86 preceding) including unique identification information based on information stored on the computer (Von Kohorn claim 27; 37:15-20).

Claim 92. The prior discloses the method of claim 63, wherein each coupon printed is printed with user- specific information (Von Kohorn, Fig. 33).

Claim 93: Von Kohorn does not explicitly disclose setting a flag to render a coupon unprintable after it has been printed to protect against fraud. However, Von Kohorn discloses unique coupons (claim 27; 37:15-20). And, Saigh discloses printing limits to prevent fraud or theft (6:47-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time of the invention to combine the features of the

two inventions since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 94. The prior discloses the method of claim 63, further comprising: receiving redemption information regarding one or more printed coupons that have been redeemed; and storing the redemption information at the internet-accessible location (Von Kohorn Fig. 33; 102:30-109:2).

Claim 95. The prior discloses the method of claim 94, wherein the redemption information is associated with a user associated with the computer (Von Kohorn, 3:57-65).

Claim 96. The prior discloses the method of claim 94, wherein the redemption information is associated with an account associated with the computer (Von Kohorn, 3:57-65).

Claim 97. The prior discloses the method of claim 63, further comprising: receiving redemption information and using the received redemption information to generate at least one subsequent coupon targeted specifically at the user (Von Kohorn , 106:5-10).

Claim 98: Von Kohorn does not explicitly disclose wherein the at least one subsequent coupon is provided to the user via an electronic mail message. However, Von Kohorn discloses electronic coupon distribution (see citations above). And, Saigh discloses email and coupons and shopping (14:25-31). Therefore, it would have been

obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn's electronically distributed coupons can be distributed via email. One would have been motivated to do this in order to better provide a coupon distribution method of convenience to the user.

Claim 99. The prior discloses the method of claim 97, wherein the at least one subsequent coupon is downloaded from the Internet accessible location (Von Kohorn, claim 27).

Claim 100. The prior discloses the method of claim 97, wherein the at least one subsequent coupon is provided to the user at a regular interval (Von Kohorn, 103:13-16).

Claim 101. The prior discloses the method of claim 97, wherein the at least one subsequent coupon is for a product other than a product covered by a redeemed printed coupon (Von Kohorn, 102:40-103:45).

Claim 102. The prior discloses the method of claim 97, wherein the at least one subsequent coupon is for a same product covered by a redeemed printed coupon, but has a different monetary value (Von Kohorn, 102:65-70).

4. Claims 47 and 52 and 63 and 64-102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Hohorn (5,227,874) in view of Saigh (5,734,823) in view of Crawford (6,411,943) OR Crawford (7,080,051)].

Please see the rejections stated above.

And, note the addition of the Crawford reference to the rejection stated above.

Von Kohorn does not explicitly disclose encrypting the transmitted unique user identifier.

However, Crawford (6,411,943) discloses encrypting the transmitted unique user identifier (claim 14).

Alternatively Crawford (7,080,051) discloses encrypting the transmitted unique user identifier (Claim 1; also, see claim 3 preamble; and, claims 3, 10, 13-17 and 20-22).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made that Von Kohorn's transmitted unique identifier can be encrypted. One would have been motivated to do this in order to better secure the validity of the unique identifier of the user.

Claims 64-102: Please see the rejection of claims 64-102 above.

Response to Arguments

Applicant's arguments with respect to the claims have been considered but are not found persuasive. Please see the comments below.

On page 10 of the Applicant's Remarks dated 1/27/2009, Applicant states, "Applicants traverse this rejection and maintain the arguments previously presented in the Response filed on October 31, 2007, which are also applicable to independent claim to claim 63".

This is the only argument the Applicant makes on 1/27/2009.

Since the Argument is the same as that filed on 10/31/2007, please see the Rejection and Response to Arguments dated 12/27/2007 which responds to the 10/31/2007 arguments.

Additionally, newly added new dependent claims 64-102 are rejected above.

Also, no independent claims were amended, hence the rejection of the independent claims has not been changed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (571)272-6718. The examiner can normally be reached on Mon- Fri, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 3622

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3/3/2009